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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/889,889 07/08/97 SULLIVAN F 063074.0104

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EXAMINER

LE,V

ART UNIT

PAPER NUMBER

2713

7

DATE MAILED:

07/07/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/889,889

Applicant(s)
Sullivan et al

Examiner
Vu Le

Group Art Unit
2713



☒ Responsive to communication(s) filed on Apr 19, 1999 (Paper No. 6)

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-42 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-42 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

VU LE
PATENT EXAMINER

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Response to Arguments

1. Applicant's arguments filed April 19, 1999 have been fully considered but they are not persuasive.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-4, 11-14, 22-25 and 33-36 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-5 and 11-15 of copending Application No. 08/677,513. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

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Both claimed inventions, as appeared in the above identified claims, recite substantially the same system and method steps of video surveillance comprising a client and a server, both coupled together via a communications network; the video surveillance can be implemented in a point-of-sale environments e.g., ATM, retail stores, etc... for communicating financial transactions and/or a sale of an item; both the client and server a microphone generate audio associated with the financial transaction; and both can transmit data, video, and audio over the communications network.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishida et al, US Pat. No. 5,585,839 for the same reasons as set forth in the last Office Action.

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Response to remarks:

For a patent claim to have been anticipated under 35 U.S.C. § 102, all the elements in the claim (or possibly their equivalents) must have been disclosed in a single prior art reference or device. Radio Steel & Mfg. Co. v. MTD Products, Inc., USPQ 657, 661 (Fed. Cir. 1984).

The examiner emphasizes that the video conversation/monitoring system of Ishida et al, US Pat. No. 5,585,839 anticipates the limitations set forth in claims 1-42.

Applicant contends that the Ishida patent fails to disclose, teach or suggest the client “the client operable to store data and video” when the data is “associated with at least one financial transaction”(Paper No. 6, page 11, section III [A]). The examiner disagrees.

It is emphasized that the Ishida patent discloses an end station (i.e., equivalent to the remote station as claimed) and the center station (i.e., equivalent to the server station as claimed). Both the end station and the center station perform coding and decoding of still image, moving image, sound and data signals (col. 5, lines 40-51). The encoding and decoding of all these media are referenced in two US patent applications 07/913,402 (now U.S. Pat. No. 5,790,178) and 07/838,348 (now U.S. Pat. No. 5,396,269), which are incorporated in the patent.

Thus, the end station (i.e., the client) does indeed operable to transmit data and video as claimed.

Applicant further contends that Ishida fails to disclose, teach or suggest a client operable to “accumulate and store the data and video as a digital file”, and the “server operable to receive the digital file upon connection from the client. (Paper No. 6, page 13, section III [B] & [C]).

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The examiner disagrees.

In Ishida, it is disclosed that both the end station (i.e., equivalent to the remote station as claimed) and the center station (i.e., equivalent to the server station as claimed) perform coding and decoding of still image, moving image, sound and data signals (col. 5, lines 40-51). The video, audio and various other data are digitized, buffered or stored, and multiplexed prior to transmission via ISDN, which is a digital network for transporting digital multi-media. The end station and the center station conduct two-way communications between one another via an ISDN network, which by the way, is a digital network.

Thus, contrary to the applicant's assertion, the Ishida patent does indeed disclose that the end station and the center station perform digital conversions of video, audio and data, store and multiplex the multi-media in digital file, and that the end station and center station exchange information via two-way communications through an ISDN network.

Applicant contends that Ishida fails to disclose "a point-of-sale device and the financial transaction comprises the sale of an item". (Paper No. 6, page 14, section III [D]). The examiner disagrees.

Ishida discloses that the video conversation/monitoring system can be used for various environments, including ATM, department stores, bank, etc... (col. 17, lines 52-65). The suggestive language above is indicative that the system is flexible and can be implemented to facilitate various activities such as retails, banking, ATM, etc... . The type of financial transaction is irrelevant and only serves as a preferential field of use. It is noted that the manner or method in

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which a machine is to be utilized is not germane to the issue of patentability of the machine itself.

In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963).

What is important is that Ishida discloses a video conversation/monitoring system which can be implemented in various environments such as ATM, bank, department store, post-office, etc..., wherein the system is capable of generating data, graphics, audio, video, and text for facilitating a two-way communications during any particular activity the system is tailored to accommodate (see fig. 23; col.17, lines 52-65).

Because Ishida discloses that his invention can be tailored to accommodate retail sales, features such as “a point-of-sale device” and “a financial transaction” regarding the sale of an item as claimed would have been inherent in such environment.

Applicant further argues that while the ATM and the video conversation/monitoring system disclosed in Ishida are co-located in a room, Ishida fails to disclose “the financial transaction comprising a cash withdrawal”. (Paper No. 6, page 14, section III [D]). The examiner takes issue with this argument.

Because the system in Ishida can be tailored to accommodate an ATM transaction, a cash withdrawal would have inherently fall under one of the ATM transactions.

The remaining issues concerns with data pertaining to a financial transaction, wherein, such data are overlay over video data. Applicant contends that what Ishida discloses (i.e., col. 8, lines 40-44) is not the same since the data is not a financial data, but rather, a guidance data. The examiner takes issue with this argument.

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Again, the system in Ishida can be tailored for various applications. A user is guided through an overlay of data over video. If the system were designed for an ATM application as suggested in Ishida, then the guidance information would have been inherently financial information overlaying video information as claimed.

Again, it is emphasized that the manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself. In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). What is important is that Ishida discloses a video conversation/monitoring system which can be implemented in various environments such as ATM, bank, department store, post-office, etc..., wherein the system is capable of generating data, graphics, audio, video, and text for facilitating a two-way communications during any particular activity the system is tailored to accommodate (see fig. 23; col.17, lines 52-65). The data, graphics, audio, video and text information are all dependent on the type of application which is intended.

For the reasons above, the examiner's position remains unchanged.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contacts

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Vu Le whose telephone number is (703) 308-6613 and email is "Vu.Le@uspto.gov". The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tommy Chin, can be reached on (703) 305-4715. The fax number for submitting formal communications is (703) 308-5359.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.



VU LE
PATENT EXAMINER